

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 21

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte MINGMING FANG, SHUMIN WANG, and HOMER CHOU

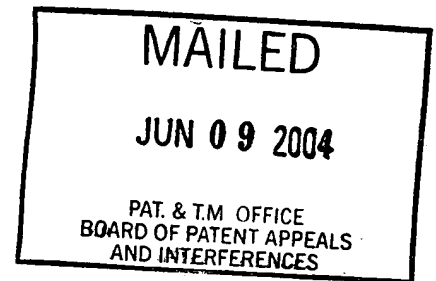
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Appeal No. 2004-1296  
Application No. 09/595,227

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ON BRIEF

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Before CAROFF, TIMM, and DELMENDO, Administrative Patent Judges.  
CAROFF, Administrative Patent Judge.

REMAND TO THE EXAMINER

The appellants appeal from the examiner's final rejection of claims 1-23, all of the claims now pending in appellants' application.

An appeal brief, an examiner's answer, and a reply brief are of record. Upon careful consideration of the issues raised by the appellants and by the examiner, we find that the appeal is not ripe for a decision on the merits. In particular, we find that the examiner has not had an opportunity to address an issue

raised for the first time in appellants' reply brief (page 5).

As indicated in the reply brief, Huynh et al. (the primary reference relied upon by the examiner) suggests that the pH buffering component of their polishing slurry "does not change the polishing rate to any noticeable degree." See Huynh et al. at col. 4, ll. 18-20. Yet, appellants' application, e.g., Example 1 (pages 9-10), appears to show that when nickel-phosphorus coated memory disks are polished with a composition including phosphate or phosphonate ion at a molarity of 0.04 M or higher, the polishing rate is enhanced. Thus, it would appear that, in the environment defined by appellants' claims, phosphate or phosphonate ions produce an unexpected result as distinguished from their mere disclosure in Huynh et al. as one of many alternative buffering agents.

In evaluating the data presented in appellants' specification, the examiner should specifically consider whether any evidence of unexpected results is commensurate with the scope of appellants' claims.

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Accordingly, we shall remand this application to the examiner to address the aforementioned issue raised in appellants' reply brief, and to determine whether the examples presented in appellants' application are indicative of unexpected results and thereby provide sufficient evidence to overcome the rejections applied against the claims on appeal.

Pursuant to 37 CFR § 1.193(b)(1), this application is hereby remanded to the examiner, via the Office of a Director of the involved Technology Center, for appropriate action consistent with the foregoing comments. In this regard, the examiner should provide a supplemental examiner's answer if the examiner decides to maintain the rejections of appellants' claims.<sup>1</sup>

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<sup>1</sup>If the rejections are maintained, the examiner should also clarify which claims are being rejected, since claims 13-16 apparently were inadvertently omitted from the statement of the grounds of rejection on page 3 of the examiner's answer.

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This application, by virtue of its "special" status, requires immediate action on the part of the examiner. See Manual of Patent Examining Procedure (MPEP) § 708.01 (8<sup>th</sup> Ed., Rev. 1, Feb. 2003). It is important that the Board be informed promptly of any action affecting the appeal in this application.

REMANDED



MARC L. CAROFF )  
Administrative Patent Judge )



CATHERINE TIMM )  
Administrative Patent Judge )



ROMULO H. DELMENDO )  
Administrative Patent Judge )

BOARD OF PATENT  
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INTERFERENCES

MLC/hh

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